

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Pugh et al.

App. No.: 09/601,028

Filed: July 26, 2000

For: A SYNTHETIC BIOMATERIAL COMPOUND

Confirmation No.:

Group Art Unit: 1616

Examiner: R. DeWitty

October 29, 2001

Commissioner for Patents
Washington, DC 20231

RESPONSE

Sir:

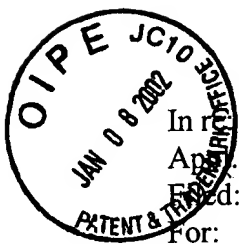
This is in response to the election of species requirement mailed June 27, 2001, in the above-referenced application. Claims 1-52 are pending, and Claims 7, 15, 51 and 37-52 are subject to an election of species requirement.

In paragraph 1 on page 2 of the Office Action, the Examiner argues that Claims 1, 10 and 43 are generic to a plurality of disclosed patentably distinct species comprising calcium hydroxyapatite, α -TCP, β -TCP, octocalcium phosphate, tetracalcium phosphate, dicalcium phosphate, and calcium oxide (as recited in dependent Claims 7, 15 and 51). Applicants elect with traverse the compound calcium hydroxyapatite for substantive examination at this time.

In this regard, Applicants respectfully note that the claimed invention as recited in independent Claims 1, 10 and 43 is directed to a novel bioresorbable biomaterial compound. This novel compound can be combined with any one of the calcium materials recited in dependent claims 7, 15 and 51. Thus, this application merely requires a single search directed to the novel compound per se as recited in claims 1, 10 and 43, regardless of what, if any, additional materials (such as those compounds recited in claims 7, 15 and 51) are combined therewith.

In addition, Claims 7, 15 and 51 recite a Markush group. Applicants respectfully submit that the members of the Markush group are sufficiently few in number so that a search and examination of the entire claim can be made without serious burden.

To the extent that the Examiner maintains his election of species requirement, Applicants understand that, upon the finding of an allowable species, examination will continue with the



#8
5/16/02
176-02

non-elected species until all species have been examined or a non-allowable species is found, all in accordance with the procedures set forth in MPEP Section 803.02.

With regard to paragraph 2 on page 2 of the Office Action, the Examiner argues that Claims 37-52 are directed to more than one species of the generic invention. Applicants elect with traverse the method recited in Claim 37. Applicants again note that the invention is directed to a novel compound per se and its uses as recited in Claims 37-52. Accordingly, searching the recited uses would not require an unduly extensive and burdensome search for the Examiner. }

Applicants submit that Claims 1, 10, 37, 43, 44, 45, 46, and 47 are generic to the invention and Claims 7, 15, and 51 are specific to the elected species.

Applicants respectfully submit that the foregoing places this case into condition for substantive examination, which action is respectfully requested.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,

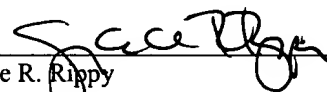


Melissa B. Pendleton
Registration No. 35,459

Customer No. 00826
ALSTON & BIRD LLP
Bank of America Plaza
101 South Tryon Street, Suite 4000
Charlotte, NC 28280-4000
Tel Charlotte Office (704) 444-1000
Fax Charlotte Office (704) 444-1111
CLT01/4503351v1

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, Washington, DC 20231, on October 29, 2001.


Grace R. Rippey